Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
65858-0024	

Application Number	Filed
10/666,171-Conf. #7110	September 19, 2003

First Named Inventor: Samer R. White

Art Unit	Examiner
2128	D. Silver

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant /inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 51,472
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____

Signature

Charles A. Bieneman
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March 9, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of 1 forms are submitted.

Pre-Appeal Brief Request for Review

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted by facsimile to the Patent and Trademark Office, facsimile no. (571) 273-8300, on the date shown below.

Dated: March 9, 2007 Signature: Heather Edwards (Heather Edwards)

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Dated: March 9, 2007 Signature: Heather Edwards
(Heather Edwards)

Docket No.: 65858-0024
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Samer R. White

Application No.: 10/666,171 Confirmation No.: 7110

Filed: September 19, 2003 Art Unit: 2128

For: METHOD FOR SIMULATING A PRE-IMPACT BRAKING SEAT BELTED OCCUPANT Examiner: D. Silver

PRE-APPEAL BRIEF

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This pre-appeal is filed under the Pre-Appeal Brief Conference Pilot Program in response to the decision of the Primary Examiner dated December 14, 2006 ("Final Office Action") , and also the Advisory Action dated February 13, 2007. The Final Office Action finally rejected pending claims 1-21, including independent claims 1 and 8. No other claims are pending. All pending claims are reproduced in a claims appendix attached hereto. This Pre-Appeal Brief is being submitted with a Pre-Appeal Brief Request for Review (Form PTO/SB/33). Further, a Notice of Appeal pursuant to 37 C.F.R. § 41.31 is being filed concurrently herewith.

In the Final Office Action (page 5), claims 1, 2, 4-17, and 21 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,522,998 ("Mazur") "and Mathwarehouse.com to show that the features claimed are inherent. See MPEP 2131.01." Claims 3 and 18-20 were rejected under 35 USC § 103(a) as allegedly unpatentable over Mazur in view of Official Notice. (Final Office Action, page 8.) This Pre-Appeal Brief focuses on the Examiner's clear error in the rejections of claims 1 and 8, although Applicant intends to set forth additional reasons supporting

the patentability of his claims, including the separate patentability of dependent claims, in an appeal.

Argument

Applicant's independent claims each recite a test dummy, a first point that is a pivot point fixed with respect to the test dummy, a second point fixed with respect to the dummy and offset from the first point at which a linear force is applied, and a third point offset from each of the first and second points for measuring displacement of the test dummy. (See claims 1 and 8.) In contrast, Mazur, the primary cited reference, teaches applying a force to, or pivoting, a seat on which a dummy rests, whereupon, as the result of momentum, the dummy is "urged away from the seat." (Mazur, 4: 30.) Thus, as explained in more detail below, Mazur clearly does not, and cannot, teach or suggest any points with respect to a test dummy, much less the first, second, and third points recited in Applicant's independent claims. Therefore, the Pre-Appeal panel is respectfully urged to issue a decision stating that this application is allowed on the existing claims.

I. "said first point selectively acting as a pivot point for said test dummy"

Independent claim 1 recites in part "securing a test dummy at a first point that is both fixed with respect to said test dummy and fixed with respect to a fixed frame of reference, said first point selectively acting as a pivot point for said test dummy." Independent claim 8 recites in part "a first point fixed with respect to said test dummy and with respect to a fixed frame of reference, said first point selectively acting as a pivot point for said test dummy." While Mazur does disclose a test dummy, Mazur actually teaches securing a seat on which a dummy rests – and not the dummy – to a pivot point. (E.g., Mazur, Fig. 4.) Mazur's system would plainly be inoperative if both the seat and dummy were secured to a pivot point. For at least this reason, Mazur cannot possibly teach or suggest the foregoing limitations of claims 1 and 8.

Mazur discloses that a "seat 12 is pivotally located on and moveable with the impact sled 10a at a pivot point 20." (Mazur, Fig. 4; 3: 46-47.) The dummy may be secured to the seat by a seatbelt or Velcro. (Mazur, 4: 2-15.) However, Mazur's dummy is not secured to a pivot point and moreover clearly does not pivot. In fact, when the seat 12 is pivoted, it "contact(s) the stop 24 rapidly halting the motion of the seat," and "as a result of momentum transfer, the dummy 14 is urged away from the seat 12 in a forward direction as shown into the pre-impact position." (Mazur, 4: 24-32.) Note that Mazur's object is to simulate "both pre-impact and impact conditions."

(Mazur, 1: 63-64.) Mazur's Figures 2-7 all clearly show the test dummy 14 being urged away from the seat 12 with no one point acting as a pivot point. Clearly, if Mazur's dummy 14 was secured to a pivot point, the goal of simulating pre-impact conditions by effectively separating the dummy 14 from the seat 12 could not be achieved. Thus, Mazur fails to teach or suggest "said first point selectively acting as a pivot point for said test dummy," and in fact teaches against this recitation.

II. "applying a linear force to a second point that is fixed with respect to said test dummy and offset from said first point"

Independent claim 1 recites in part "applying a linear force to a second point that is fixed with respect to said test dummy and offset from said first point." Independent claim 8 recites in part "a second point fixed with respect to said test dummy and offset with respect to said first point; . . . wherein application of a linear component of a force at said second point, . . . causes a measurable amount of forward-directed linear displacement of said second point with respect to said fixed frame of reference while pivoting said test dummy about said first point in both a forward and downward direction . . ." Mazur entirely fails to anticipate these recitations.

Mazur teaches at most applying a force to the seat 12, and not to any points relative to the test dummy 14. For example, Figure 5 of Mazur illustrates that "seat 12 is slidable on the track 38" and that a force may effectively be applied to seat 12 by releasing a spring 40. (Mazur, 5: 28-45.) Figure 6 shows springs 58 compressed by a latch mechanism for accelerating the seat 12. (Mazur, 5: 56 - 6: 3.) In other words, Mazur's object is to accelerate the seat 12. Applying a force to any portion of the test dummy 14 would defeat Mazur's purpose of determining the response of the dummy 14 to acceleration of the seat 12. In short, Mazur cannot teach or suggest the foregoing recitations of claims 1 and 8, which each plainly require application of a linear force at "a second point fixed with respect to said test dummy and offset with respect to said first point."

III. "establishing a third point that is fixed with respect to said test dummy and offset from said first point and said second point"

Independent claim 1 recites in part "establishing a third point that is fixed with respect to said test dummy and offset from said first point and said second point." Independent claim 8 recites in part "a third point fixed with respect to said test dummy and offset with respect to said first point and said second point." As explained above, Mazur teaches neither "said first point" nor "said second point," and thus cannot teach or suggest a third point offset from the first and second points.

The Examiner asserted that the foregoing recitations of claims 1 and 8 were anticipated by "Fig[.] 5 dummy 14 before and after shown by arrow." (Final Office Action, page 5.) However, Mazur's Figure 5 simply shows the dummy 14 moving from the seat 12 as the seat 12 is stopped at point B after being accelerated from point A by release of spring 40. (See Mazur, 5: 42-52.) Mazur makes no teaching or suggestion at all of any point, much less the recited "third point," being established with respect to his dummy 14. Indeed, a casual inspection of Figure 5 of Mazur shows that the dummy 14 is not secured at any fixed point, that no linear force is applied to any point fixed with respect to the dummy 14, and at no point is established and displaced with respect to the dummy 14 and offset from the first and second points. Thus, Mazur in no way teaches or suggests the respective recitations in claims 1 and 8 of "establishing a third point that is fixed with respect to said test dummy and offset from said first point and said second point" and "a third point fixed with respect to said test dummy and offset with respect to said first point and said second point."

IV. "estimating an amount of said forward-directed displacement occurring at said third point . . ."

Independent claim 1 recites in part "estimating an amount of said forward-directed displacement occurring at said third point . . ." Independent claim 8 recites in part "said forward displacement of said third point being estimated . . ." The Examiner appears to have conceded that these limitations are not taught or suggested by Mazur, arguing that they are "an inherent feature." (Final Office Action, page 5.) That is, the Examiner has asserted that the manner of estimating the displacement recited in Applicant's claims is inherent (Final Office Action, page 5). Applicant does not concede this assertion, and moreover, the Examiner has failed to meet the Office's burden of asserting, much less showing, that "estimating" displacement or displacement "being estimated" are themselves inherent in the context of the other elements of Applicant's claims. For at least this reason, a Section 102 rejection based on Mazur is improper.

The law allows a rejection based on inherency only when "the missing descriptive matter is necessarily present in the thing described in the reference." MPEP 2131.01(III) (citing Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). Here, the Examiner has made absolutely no showing that "estimating" displacement or displacement "being estimated" are necessarily present in the system disclosed by Mazur. In fact, as discussed above, the purpose of the invention of Mazur is to simulate "impact conditions." (Mazur, Abstract.)

Therefore, the Examiner's inherency rejection is appropriate only if "estimating" displacement or displacement "being estimated" are inherent features of a device that simulates impact conditions. Applicant respectfully submits that such inherency clearly does not exist, and that moreover, no showing of such inherency has been made.

Specifically, the Examiner made no showing that either "estimating an amount of said forward-directed displacement occurring at said third point" or "said forward displacement of said third point being estimated" is inherent. The Examiner's argument from inherency appears to be based on the Examiner's assertion that Applicant's claims allegedly recite well-known geometric properties to perform the recited estimation of displacement. (See Final Office Action, page 5.) However, even if Applicant is reciting use of well-known properties, use of such properties is not necessarily inherent, nor would use of well-known properties to estimate displacement make the estimation of displacement itself inherent. For at least this reason, the pending Section 102 rejection of Applicant's independent claims is improper.

CONCLUSION

Independent claims 1 and 8 are clearly allowable over the prior art of record for any of the foregoing independent reasons. The Pre-Appeal Panel is therefore respectfully urged to issue a decision stating that this application is allowed on the existing claims. Applicant believes that no fee is due with this Pre-Appeal Brief. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65858-0024 from which the undersigned is authorized to draw.

Dated: March 9, 2007

Respectfully submitted,

By

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